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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,515	06/18/2001	Klaus Schelberger	49651	1391

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EXAMINER
JIANG, SHAOJIA A

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/868,515	Applicant(s) SCHELBERGER ET AL.	
	Examiner Shaojia A. Jiang	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 July 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *6 and 11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 7-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on July 2, 2002 in Paper No. 7 wherein claims 1-11 have been amended. Currently, claims 1-11 are pending in this application.

Applicant's remarks (see page 6-7 of Applicant's response) regarding claims 6 and 11 being drawn to a nonelected species have been considered and found persuasive as to claim 6. Therefore, claim 6 is now drawn to the elected species. However, Applicant's remarks regarding claim 11 is not found persuasive since first, there are no clear definitions for X1 and X5; the expression "5-F" for X2 is unclear.

Therefore, claim 11 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species. See the previous Office Action dated April 23, 2002.

Applicant's remarks with respect to PCT Rule 13.2 on corresponding special technical features on claims 6 and 11 have been considered and found persuasive as to the unity of invention herein is not lacking.

Applicant's amendment filed on July 2, 2002 in Paper No. 7 with respect to the rejection of claim 10 made under 35 U.S.C. 112 second paragraph for the use of the indefinite expression, of record stated in the Office Action dated April 23, 2002 have been fully considered and found persuasive to remove the rejection since the term "harmful" has been deleted from the claim.

Claim R jections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 and 7-10 are rejected under 35 U.S.C. 112, first paragraph, for lack of enablement, essentially for reasons of record stated in the Office Action dated April 23, 2002.

Applicant's remarks filed July 2, 2002 in Paper No. 7 with respect to this rejection of claims 1-5 and 7-10 made under 35 U.S.C. 112, first paragraph of record stated in the previous Office Action (April 23, 2002) have been fully considered but are not deemed persuasive to remove the rejection as discussed below.

As discussed in the previous Office Action, synergistic or superadditive effects for combinations of compounds are highly unpredictable. In the instant case there is insufficient guidance or working examples in the specification showing amounts and particular agents to be combined which achieve synergistic effects by the fungicidal composition in the method for controlling fungi herein. The declaration of Dr. Eberhard Ammermann (submitted January 29, 2002 in Paper No. 5) is not seen to be effective to demonstrate any synergistic effects produced by the combination.

Applicant's asserts that the data, e.g., "Degree of action observed" compared with "Degree of action calculated", in Ammermann's declaration, demonstrates the claimed combination herein shows unexpected and synergistic activity against fungi. However, these data are not found clear and convincing since it is unclear as to what

the "Degree of action observed" is based on herein, or how to obtain the "Degree of action observed". Moreover, the clear explanation of pointing out exactly what facts are established therein and relied upon by applicant is not seen in the specification (see page 20). Applicant has the burden to explain the experimental evidence. See *In re Borkowski and Van Venrooy* 184 USPQ 29 (CCPA 1974).

The evidence in the declaration and specification is not seen to show clear and convincing synergy for any combination of agents within the claims. Therefore, in view of the unpredictability of such synergistically effective amounts of the claimed combination, the guidance in the specification is considered insufficient to show one of skill in the art how to practice the claimed invention without undue experimentation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwalge et al. (WO 97/06681) and Kasahara et al. (WO 96/19442, equivalent to US 5,847,005) essentially for reasons of record stated in the Office Action dated April 23, 2002.

Applicant's remarks filed on July 2, 2002 in Paper No. 7 with respect to this rejection of claims 1-5 and 7-10 made under 35 U.S.C. 103(a) as being unpatentable over Schwalge et al. and Kasahara et al. have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art for the following reasons.

Applicant's data shown in Ammermann's declaration and the specification herein have been fully considered with respect to the nonobviousness and/or unexpected results of the claimed invention over the prior art but are not deemed persuasive, as discussed above regarding the rejection made under 35 U.S.C. 112, first paragraph, for lack of enablement. Moreover, The testing herein merely demonstrate three particular compounds Ia, Ib, and Ic in combination with IIa, within the instant claims. Thus, the evidence in the examples is also not commensurate in scope with the claimed invention and does not demonstrate criticality of a claimed range of the active compounds in the claimed composition. See MPEP § 716.02(d). Therefore, the evidence presented in specification herein is not seen to support the nonobviousness of the instant claimed invention over the prior art.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

In view of the rejections to the pending claims set forth above, no claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell S. Travers, J.D., Ph.D, can be reached on (703) 308-4603. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

Shaojia A. Jiang, Ph.D.
Patent Examiner, AU 1617
August 21, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200